

30. (New) The method according to claim 23 wherein the said first part includes one or more amine reactive resins blended with the one or more polyisocyanates.

31. (New) The method according to claim 30 wherein said amine reactive resin is diglycidyl ether of bisphenol A or selected from the group comprising Dipenta-erythritol pentaacrylate.

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32. (New) The method according to claim 23 wherein the mixture is applied through heated airless spray equipment.

33. (New) The method according to claim 32 wherein said spray equipment includes a centrifugal spinning head or self-mixing spray gun assembly.

Remarks.

In the Office Action of September 26, 2002, claims 1-8 and 11-17 stand rejected. Claims 1-8 and 11-17 are canceled in this response and new claims 23-32 are presented. Reconsideration and allowance of all pending claims are respectfully requested in view of the following remarks.

A. Double Patenting Rejection

Claims 1-4, 6-8, 11-13 and 15-17 stand rejected under the judicially created doctrine of obvious type double patenting as being unpatentable over claims 1 and 5-8 of U.S. Patent No. 6,074,702. The Examiner argues that while the claims are not identical, they are not patentably distinct because they are broader and thus inclusive of the method of the claims of U.S. Patent No. 6,074,702.

Claims 1-4, 6-8, 11-13 and 15-17 have been canceled. New claims 23 through 32 are presented. Claim 23, recites, in part, "providing a second part comprising one or more aromatic polyamines and one or more oligomeric polyamines blended together." None of the claims of the 6,074,702 patent contain a second part as is recited in the present invention. Thus, the double patenting rejection should be withdrawn.

B. Section 112 rejection

Claims 1-8 and 11-17 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, the Examiner argues that for claim 1, the recitation of a surface with the phrase, “for example...” is indefinite. Claim 1 has been canceled, rendering this rejection moot. New independent claim 23 does not include the language objected to by the examiner.

For claims 6 and 15, the Examiner objects to the phrase “rapid setting”. Claims 6 and 15 have been canceled, rendering this rejection moot. None of the new claims contain the phrase “rapid setting”. Thus, this rejection should be withdrawn.

For claims 11-17, the Examiner objects to these claims because they are method claims dependent on a product or apparatus claim. These claims have been canceled, rendering this rejection moot.

C. Section 102 rejection

Claims 1-4, 6-8, 11-13, and 15-17 stand rejected under 35 U.S.C. 102(b) as being anticipated by the EP 0936 235 A1.

In order to sustain a rejection under 35 U.S.C. § 102(b), each and every element as set forth in the claim must be found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 528, 631 (Fed. Cir. 1987). Indeed, “the identical invention must be shown in as complete detail as is contained in the... claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1235 (Fed. Cir. 1987). Because the claims of the present invention contain elements not found in EP 0936 235 A1, the rejection should be withdrawn.

Initially note that claims 1-4, 6-8, 11-13 and 15-17 have been canceled, rendering those specific rejections moot.

Considering claim 23, claim 23 recites, in part, “providing a second part comprising one or more aromatic polyamines and one or more oligomeric polyamines blended together.” Nowhere in the cited reference (EP 0936 235 A1) is such a second part disclosed, taught or suggested. At most, Table IV of EP 0936 235 A1 discloses the use of an oligomeric polyamine alone with a polyisocyanate. Thus, EP 0936 235 A1 does not anticipate new claim 23 or any of the claims that depend from claim 23.

D. Section 103 rejection

Claims 5 and 14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0936 235 A1. The Examiner argues that while the reference does not disclose the use of one or more oligomeric polyamines with one or more aromatic polyamines, such use would be obvious given Table IV of EP 0936 235 A1, which discusses the use of two specific oligomeric polyamines, because the success of Table IV is similar to what is disclosed in EP 0936 235 A1.

To establish a prima facie case of obviousness under 35 U.S.C. § 103, three requirements must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. (M.P.E.P. 2143).

Initially note that claims 5 and 14 have been canceled rendering the rejections of those specific claims moots.

Additionally, the discussion of oligomeric polyamines in Table IV of EP 0936 235 A1 does not suggest or motivate “providing a second part comprising one or more aromatic polyamines

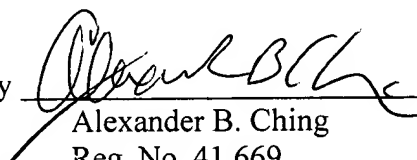
and one or more oligomeric polyamines blended together” as disclosed in Claim 23. Table IV disclose only the use of an oligomeric polyamine alone with a polyisocyanate. Table IV does not disclose, teach or suggest the use of an oligomeric polyamine with an aromatic polyamine nor is there any suggestion or motivation in EP 0936 235 A1 to use both aromatic polyamines and oligomeric polyamines. Indeed, Table IV teaches away from the use of oligomeric polyamine for in situ applications in water pipelines. As noted in EP 0936 235 A1, the gel time of the combinations of Table IV are so short the use for in situ applications is impractical. (Paragraph 32, line 3). Also, as noted in Table IV, the chemicals used in Table IV were very sensitive to water environments. Thus, EP 0936 235 A1 specifically teaches away from the use for the cited oligomeric polyamines for in situ coating of water pipelines. Therefore, the Examiner’s section 103(a) argument would not apply to new independent claim 23 or claims 24-32, which depend from claim 23.

Conclusion

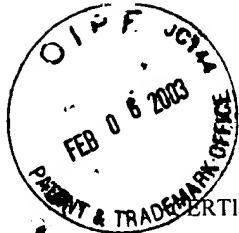
The Examiner is invited to telephone the undersigned at the telephone number listed below if it would in any way advance prosecution of this case. Enclosed is a request for a one-month extension of time. Please charge the fee to **Deposit Account No. 19-3878**. Although no additional fees are believed due, Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to **Deposit Account No. 19-3878**.

Respectfully submitted,

1-27-03
Date

By 
Alexander B. Ching
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CERTIFICATE OF MAILING PURSUANT TO 37 C.F.R. §1.8

I, Alexandre Chins, hereby certify that this correspondence, pursuant to 37 C.F.R. §1.8, is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231, on: _____
Date: 1-27-03 By Alexandre Chins

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Ian Robinson Docket No.: 32093.00006
Application No.: 09/781,596 Group Art Unit: 1762
Filing Date: February 12, 2001 Examiner: Crockford, Kristen Anne
TITLE COATING FOR DRINKING WATER PIPELINES

TRANSMITTAL OF RESPONSE TO OFFICE ACTION

Commissioner for Patents
Washington, D.C. 20231

Commissioner:

Herewith is a response in the above-identified application to the Office Action mailed on **September 26, 2002**. Applicants hereby petition, pursuant to 37 C.F.R. §1.136, that the shortened statutory response period be extended for **one (1) month** until **January 26, 2003**. The fee set forth in 37 C.F.R. §1.17 is enclosed.

FEE CALCULATION, CLAIMS AS AMENDED:

	Claims remaining after amendment		Highest number previously paid for		Present Extra				Additional Fee
Total Effective Claims	11	minus	22	=	0	x	\$ 18.00	=	\$.00
Independent Claims	1	minus	3	=	0	x	\$ 84.00		0.00
							Subtotal:		\$.00

Subtotal: \$.00

Fee Calculation: Request for extension of time pursuant to 37 C.F.R. §1.136(a)

<input checked="" type="checkbox"/>	Response filed within first month after due date – add	\$ 110.00
<input type="checkbox"/>	Response filed within second month after due date – add	\$ 400.00
<input type="checkbox"/>	Response filed within third month after due date – add	\$ 920.00
<input type="checkbox"/>	Response filed within fourth month after due date – add	\$1440.00



☐ Response filed within fifth month after due date – add \$1960.00

Subtotal: \$110.00

If one of the “small entity” boxes above is checked, enter half (1/2) of the second subtotal and subtract.

\$ 0

TOTAL ADDITIONAL FEE ENCLOSED: \$110.00

☒ Please charge Deposit Account No. 19-3878 in the amount of \$ 110.00.

A duplicate copy of this sheet is attached.

☐ A Squire, Sanders & Dempsey L.L.P. check in the amount of \$ ____ is attached.

This statement does NOT authorize charge of the issue fee. The Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any deficiency in the fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under 37 C.F.R. §§1.16-1.18 (deficiency only) now or hereafter relative to this Application and the resulting Official document under 37 C.F.R. §1.20, or credit any overpayment to Account No. 19-3878 for which purpose a duplicate copy of this sheet is attached.

Respectfully submitted,

1-27-03

Date

By

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